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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/741,207
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	First Named Inventor	Timothy P. Barber
	Art Unit	3624
	Examiner Name	Daniel S. Felten
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Ware, Fressola, Van Der Sluys & Adolphson LLP		
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Att. Docket 2-604.6-1
Ser. No. 09/741,207

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

First named inventor: Barber, Timothy P.

Serial No.: 09/741,207

Filed: Dec. 19, 2000

Title: Method for Secure, Closed Loop Money Transfer via
Electronic Mail

Group Art Unit: 3624

Examiner: Felten, Daniel S.

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REPLY TO EXAMINER'S ANSWER

Sir:

This paper is in reply to the Examiner's Answer mailed on
Jan. 9, 2007.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

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REMARKS

In the Appeal pending in this matter, applicant hereby acknowledges receipt of the Examiner's Answer mailed 9 Jan. 2007. Applicant notes that the Examiner's Answer does not contain a rejection designated as a new ground of rejection, although the rejection of claim 1 is now indicated as under 35 USC 103(a) as being unpatentable over Kuzma (US 5,771,289) in view of Kuzma (US 5,771,289) in view of Messner (US 6,370,514)" but applicant believes that this is typographical error, and anyway, it is not designated as a new ground of rejection. Therefore a reply brief is not required to maintain the appeal, and applicant hereby requests that the appeal be maintained. In addition, though, applicant responds to the Examiner's Answer as follows:

In "Response to Argument" at page 7 of the Examiner's Answer, the Examiner seems to concede that the Office "focuses too much on the use of the word 'stamp' ... in the claims." (A stamp, as recited, is affixed to an email and redeemable for a value indicated thereon, and thus serves as a reward to the recipient for having gone to the trouble to redeem it, and probably having read the email.) Applicant has suggested that a fair reading of the claims would interpret the term "stamp" as "reward indicia." It seems from the Answer that the Examiner is agreeable to this interpretation. Applicant nonetheless, just to be certain that the Office construes "stamp" when recited in the claims to mean reward indicia instead of its more usual meaning, refers the Office to *Phillips vs. AWH Corp.*, 415 F.3d 1303, 75 USPQ.2d 1321 (Fed. Cir. 2005), an *en banc* decision, where the court explained again that:

[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term. ... That [the specification] starting point [for understanding a

claim term] is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. ... Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.

The word "stamp" as used in the claims is thus fairly construed as used in the specification and as impliedly defined in the claims themselves, which is different than its normal meaning (indicating an amount paid for delivery of a message). A "stamp" as recited in the claims must be construed as indicating a reward for having redeemed it. A "stamp" as recited in the claims thus differs fundamentally from the "stamp" disclosed in Kuzma, which is explained to be a packet of data instructing an electronic post office (250) that an electronic message (202) should be transmitted, possibly including a unique code for authenticating the stamp, and possibly a graphic indicating cancellation, but of course nowhere indicating a value available to someone who might "redeem" the stamp as in the invention. To distinguish here from the stamp recited in claim 1 and the stamp disclosed in Kuzma, the latter will be referred to here as a Kuzma stamp.

The Examiner next asserts that appellant's brief argues the references individually, and points out that this cannot be done when, as here, the rejections are based on combinations of references. Applicant respectfully submits that appellant's brief argues specific assertions made by the Office, not references. Some of these assertions are that Kuzma by itself teaches some limitations recited in the claims, and some assertions are that Kuzma in combination with Messner, i.e. as modified by the teachings of Messner, teaches others of these limitations. In respect to the combination, appellant's brief also argues that there is no motivation to alter the teachings of

Kuzma according to the teachings of Messner as in the Office action, i.e. to replace the electronic stamp of Kuzma with the voucher of Messner.

To summarize, appellant's brief disputes the following assertions by the Examiner in the Office action mailed June 16, 2005 (and repeated in the Examiner's answer):

that Kuzma discloses a method of providing for a money transfer over a network (the brief arguing that Kuzma discloses instead affixing to an email an electronic analog of an ordinary postage stamp, i.e. a Kuzma stamp, which is only proof of money having been spent, not a transfer of money);

that Kuzma discloses a step of providing a stamp (as in the invention) having a face value indicated on the stamp (the brief arguing that Kuzma nowhere discloses a "stamp" as that term is used in the claims, and any "value" that might be indicated by a Kuzma stamp--and it is not clear that any value is indicated--is not a value indicating an amount of money for which the stamp can be redeemed, as required by claim 1, but would be merely the amount of postage paid for);

that Kuzma discloses a stamp being a string that is a concatenation of two or more fields including the face value (the brief arguing that Kuzma nowhere discloses the use of concatenation in forming a Kuzma stamp, and even if concatenation were used, since Kuzma does not disclose a face value as that term is used and defined in the claims, Kuzma cannot be said to disclose a concatenation of fields including the face value);

that there is motivation to change the teachings of Kuzma according to the teachings of Messner by replacing the Kuzma stamp with a Messner voucher, and further, that it would have been obvious to change the Messner voucher by indicating a lifespan on its face (the brief arguing that there would be no more motivation to so change the teachings of Kuzma than there

would be to change the ordinary mail system in the same way, using vouchers instead of postage stamps, even though vouchers, i.e. gift certificates or coupons, have been around a long time); and

that the combination of Kuzma and Messner, with the further change to show a lifespan, teaches allowing the recipient of an e-mail having a stamp (which would be the voucher of Messner, with the combination made in the Office action) obtain value for the stamp if the stamp is presented to a predetermined entity within the lifespan indicated on the stamp (the brief arguing that since Messner teaches that the voucher is paid for before it is affixed to an email, it is not likely that there would be any time limit as indeed there is no such teaching in Messner, and so the combination of what is actually disclosed by Kuzma and Messner does not teach or suggest redeeming but only if within a lifespan indicated on the stamp).

In regard to this last point, in preparing this paper applicant's attorney discovered that at col. 12, line 23, Messner discloses "a specified time frame" during which a voucher is valid, and, in case of a gift certificate, if not redeemed within the time period, the gift certificate expires and either the amount paid by the purchaser is not refunded, or it is returned, depending on whether "insurance" is also purchased by the purchaser of the gift certificate. Thus, applicant withdraws the assertion that it is not likely that there would be any time limit in case of a Messner voucher.

However, applicant now argues still further that the combination made by the Examiner is improper (besides arguing that there is no more motivation to change Kuzma per Messner than there is to change our "snail mail" system to use gift certificates in place of stamps). The MPEP at 2143.01 (V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY

FOR ITS INTENDED PURPOSE), cites *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), for the rule that, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Applicant respectfully submits that the use of Messner's vouchers in place of Kuzma's stamps would frustrate the intended purpose(s) of Kuzma, and so the combination is improper.

Kuzma explains at col. 1, line 60, that "It ... is desirable to provide a system for prepaid electronic message transmission where payments are directly proportional to use." Kuzma explains that often an electronic communication channel over which email is sent is paid for regardless of its use, and it would be perhaps beneficial to (pre-)pay as you go for email. Kuzma sets out objects, i.e. intended purposes, at col. 2, beginning line 27:

It is an object of the invention to provide a method and apparatus for paying for transmission of electronic data substantially concurrently with the transmission.

It is a further object of the invention to provide a method and apparatus for acquiring electronic stamps usable as payment for the transmission of an electronic message.

It is a further object of the invention to attach the electronic stamps to an electronic message thereby providing payment for the transmission of the message.

Another object of the invention is to mark the electronic stamps after they have been used to identify them as having been used to pay for the transmission of an electronic message. [Emphasis added.]

Kuzma also explains at col. 8, line 65, that another intended purpose of the stamps of Kuzma is to "regulate" the use of e-mail so as not to overburden the email system. Thus, Kuzma can fairly be said to also have as an intended purpose the prevention of spam.

Now the combination made by the Examiner changes the teaching of Kuzma by replacing the stamp of Kuzma with the

voucher of Messner. The voucher of Messner is said to be either a gift certificate, entitling the recipient to obtain goods or services up to the amount paid, or a coupon, entitling the recipient to a discount (percentage or dollar amount) in the purchase of goods or services. Applicant respectfully points out that when the purchaser of a voucher pays for the voucher, the purchaser is not paying for the transmission of an electronic message, but is instead paying for goods and services entirely unrelated to the transmission of an electronic message. (Even the amount of a voucher belies any assertion it is useable as payment for transmission of an electronic message. The cost of an electronic message could not reasonably be more than the cost of ordinary first-class postage, since the cost of delivery is so much less. In contrast, a voucher is for a significant amount of money, enough for the recipient to acquire goods or services the recipient would like to acquire.) Thus, replacing the Kuzma stamp with a Messner voucher frustrates all of Kuzma's objects related to paying for transmission of an electronic message, since that is not what a Messner voucher does. Further, Messner vouchers are not "marked" in any way to show they have been used, and so Kuzma's object of marking stamps to identify them as having been used to pay for a transmission is also frustrated.

Moreover, replacing a Kuzma stamp with a Messner voucher will not regulate email, i.e. it will not stop spam. A spammer would not have to use a voucher, i.e. a voucher is optional (and would have to be, for the reasons given above regarding the cost of a voucher compared to the cost of a stamp), but a stamp would be required. In the alternative, if it is asserted by the Office that a voucher would be required, the amount paid for the voucher would be at the discretion of the purchaser, and so could be *de minimis*, and thus there would be a correspondingly small effect on stopping the spammer.

Applicant therefore respectfully submits that one of ordinary skill in the art would never have modified the teachings of Kuzma in view of the teachings of Messner, i.e. it would not have been obvious to make the combination made by the Examiner.

For all of the aforementioned reasons and also for the reasons given in the appeal brief, it is respectfully insisted that the rejection of claim 1, and hence of all the claims in the application, namely claims 1-8, are error, and the rejections should be reversed. Early allowance of all the claims in the application is earnestly solicited.

19 Jan. 2007 _____

Date

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Respectfully submitted,



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